

REMARKS

After entering these amendments, Claims 1-2, 4-7 and 12 will be pending. Claim 1 has been amended. Claims 8-11 and 13-21 have been cancelled without prejudice as being directed to non-elected inventions and may be the subject of a divisional application.

Applicants' attorney spoke to the Examiner briefly about amending the claims at this stage of the prosecution to overcome the prior art. The Examiner indicated that he would consider all amendments. Applicants have made every effort to amend the claims to overcome the prior art and place this case in condition for allowance.

AMENDMENTS TO CLAIM 1

Claim 1 has been amended as follows:

- a) the definition of R₁ has been amended to delete alkyl or substituted alkyl so that R₁ does not encompass arylalkyl or substituted arylalkyl and thus does not encompass the Sircar WO01/30781 variables K and R;
- b) the definition of R₆ and R₆' has been amended to delete "aryl or substituted aryl" so that the variable W as CR₆R₆' will not encompass C R₆R₆' where either of R₆ and R₆' will encompass aryl or substituted aryl and thereby the compounds as claimed in Claim 1 are outside the scope of and are not obvious from Kelly et al. (US 6,365,615).
- c) the definition of R₆ and R₆' has been amended to delete R₆ and R₆' taken together can form NR₇, so that the compounds as now claimed in Claim 1 are outside the scope of and are not obvious in view of the cited Palovich et al CAS:134:25, 357; and
- d) the definition of R₇ and R₇' has been amended to delete heteroaryl and substituted heteroaryl and the definitions of R₂, R₂', R₃, R₄, R₄', R₅, R₅', R₆ and R₆', G and W have been amended to delete heteroaryl and heterocycle, and heteroaryl and heterocycle substituents so that Claim 1 as amended is within the scope of the elected subject matter as defined on pages 2-3 of the Office Action dated June 6, 2006.

THE REJECTIONS UNDER 35 U.S.C. §102 and §103:

The Examiner states that

"since the variable R₆ or R₆' of the variable W independently represent aryl or substituted aryl when the variable G represent aryl (i.e. phenyl), the rejection of claims 1-2, 4-7 and 12 under 35 U.S.C. 102(a) and (e) or 103 (a) over Kelly et al. U.S. 6,365,615 is maintained."

Applicants have amended Claim 1 (and thereby Claims 2, 4-7 and 12) to delete “aryl and substituted aryl” from the definition of variables R_6 and R_6' . Kelly et al’s variable R^2 , (which corresponds to Applicants’ variable W being CR_6R_6'), must be aryl.

There is no disclosure or suggestion in Kelly et al. of compounds where the Kelly et al. R^2 group is other than aryl. R^2 MUST BE ARYL IN KELLY ET AL. In Applicants’ compounds as claimed W is CR_6R_6' , $C(R_6)OR_3$ or $C(R_6')(NR_4R_4')$ where R_6 and R_6' do not include aryl. Thus, Applicants’ compounds are not anticipated by and are patentable over Kelly et al.

The Examiner further states that

“Applicants still claim a compound of formula (I), wherein the variable n is 1; the variable G represents aryl (i.e., phenyl) substituted with halo (i.e., Br); the variable R_5 and R_5' taken together form a double bond with oxygen; the variable R_6 and R_6' taken together form a double bond with NR_7 and R_7 represent substituted aryl (i.e., phenyl substituted with CN, or OH); the variable R_1 represent hydrogen; the variable W represents CR_6R_6' , and R_6 or R_6' independently represents hydrogen; the variable R_2 or R_2' independently represents hydrogen, see RN 311319-99-0. The rejection of claims 1-2, 4-7 and 12 under 35 U.S.C. 102(b) over Palovich et al. CAS: 134:25357 is maintained.”

Claim 1 has been amended so that R_6 and R_6' can no longer be taken together to form a double bond with NR_7 . Thus, Applicants’ compounds as claimed are not anticipated by Palovich et al and are, indeed, unobvious in view of Palovich et al.

CLAIM OBJECTIONS:

The Examiner states that, “Claims 1-2, 4-7 and 12 are objected to as containing non-elected subject matter, i.e., heterocyclo or heteroaryl of the variable R_7 or R_7' , etc.” The Examiner suggests “that Applicants amend the claims to the scope of the elected subject matter as defined on the pages 2-3 of the previous Office action, dated 6/06/2006”. The Claims have now been amended so that R_1 , R_2 , R_2' , R_4 , R_4' , R_5 , R_5' , R_6 , R_6' , R_7 , R_7' , G and W independently do not represent heteroaryl or heterocycle or is not substituted with heteroaryl or heterocycle.

CONCLUSION:

A one (1) month extension of time is requested for the filing of a Notice of Appeal. Please charge the fee of \$120 for the extension of time to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company. If any additional fee should be found to be due please charge said fee to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

In view of the foregoing, Applicants submit that the application is now in condition for allowance. Early notification of such action is earnestly solicited.

Respectfully submitted,

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